

Serial No. 10/629,466
Attorney Docket No. IN01481KB

Remarks

Claims 21-40 are pending in the present Application. Of these claims, claims 31-40 have been withdrawn from consideration as a result of an earlier restriction requirement. In the Office Action, the Examiner maintained the earlier restriction requirement. Applicants are now canceling claims 31-40 as non-elected claims, while at the same time preserving the right to file divisional application(s) on the invention of the cancelled claims, if Applicants choose to do so. Thus, claims 21 to 30 are currently under prosecution.

1. Rejection under 35 U.S.C. §102(e)

The Examiner has rejected claims 21, 25, 27 and 29 under 35 U.S.C. 102 (e) as being anticipated by United States Patent Publication US2004/0142920, inventors Albert et. al. (hereinafter "Albert '920"). The Examiner has referred to example 58, page 11 of Albert '920 and asserts that this reference has an effective filing date of April 9, 2001. The Examiner asserts that the compound of example 58, page 11 of Albert '920 anticipates the generic scope of the present compounds of formula I, wherein R¹ and R² are non-heterocyclic, R³ is substituted or unsubstituted pyrimidine.

Albert '920 claims priority from British Application GB 0108876.4 (hereinafter "GB '876.4") filed April 9, 2001. The present application being examined has a priority date of August 29, 2001. However, example 58 of Albert '920, relied on by the Examiner to reject the present claims is missing from GB '876.4". Applicants are submitting herewith a copy of GB '876.4, obtained electronically from Online EPO File Inspection website, wherein a search for the corresponding PCT publication WO02/081449 brings up GB '876.4 as a priority document. A copy of this search result is also attached for the Examiner's convenience.

From the inspection of GB '876.4, it is clear that this reference does not disclose the chemical compound disclosed in example 58 of Albert '920. It is also clear that the contents of GB '876.4 and Albert '920 are vastly different, the former being a much shorter application than the latter. Albert '920 itself has an international filing date of April 8, 2002, which is well after the priority date of the present application. Therefore, neither GB '876.4 nor Albert '920

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can be used as a 35 U.S.C. 102(e) prior art reference. The Examiner is respectfully requested to withdraw the present rejection. In case the Examiner intends to reject the present claims based on GB '876.4 as prior art, she is respectfully requested to point out the specific disclosure of this reference to support her position.

2. Rejection under 35 U.S.C. §103

The Examiner has rejected claims 21-30 under 35 U.S.C. 103(a) as being unpatentable over Albert '920 cited above. The Examiner asserts that the difference between the elected species and Albert '920 is that instead of both R¹ and R² being optionally phenyl, the instantly elected species has one the R² moiety being benzyl. The Examiner further asserts that generically, Albert '920 taught that R² being phenyl or benzyl are optional choices for such moiety, and refers to example 58 on page 11 and example 82 on page 14 of Albert '920. She asserts that one having ordinary skill in the art would be motivated to modify the species of the elected compound with the generically taught optional choices of equivalency in replacing the phenyl moiety with a benzyl moiety with the expectation that such modification would render the modified compound having similar biological activity. Applicants respectfully disagree with the position taken by the Examiner and traverse this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 2142. None of these three criteria has been met in the present rejection, for the same reasons as set forth in the above arguments against the 102(e) rejection.

The priority document for Albert '920, namely GB '876.4, does not disclose the compounds in examples 58 and 82 of Albert '920. Thus GB

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'876.4 cannot be used as a 102(e) prior art reference in the present rejection. Furthermore, as already set forth above, the international filing date of Albert '920 is after the priority date of the present application. Thus Albert '920 itself cannot also be used as a 102(e) prior art reference in the present rejection. The Examiner is respectfully requested to withdraw the present rejection.


CONCLUSION

Applicants respectfully request prompt reconsideration of elected subject matter of claims 21-30, and an early allowance of the application.

If the Examiner wishes to comment or discuss any aspect of this application or response, applicants' undersigned attorney invites the Examiner to call him at the telephone number provided below.

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Enclosures: GB018876.4, Search result for WO02/081449 from EPO Online Public File Inspection.